

Application No.: 10/602,747

Docket No.: D8200.0004/P004

REMARKS

Claims 1, 2, 4, 8, 9 and 15 have been amended. The specification has been amended. No new matter has been added. Claims 1-4, 8, 9, and 14-16 are currently pending in this application.

The title has been amended as requested by the Examiner. The new title, "METHODS FOR THE EXPRESSION OF CODING REGIONS OF INTEREST IN *BACILLUS* SPECIES," is not meant to be limiting.

The specification has been amended to accurately reflect the status of all nonprovisional parent applications. The specification has also been amended to correct typographical errors.

Claims 4 and 9 have been amended to correct clerical errors. Applicants wish to clarify that SEQ ID NO:8 is the nucleotide sequence of a *yvaW* gene as stated on page 6 of the Specification.

Claim 15 has been amended to correct a typographical error. The amendment to claim 15 is not intended to alter the scope of any claims.

Claims 1-3, 8, and 14-16 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

The Examiner contends that because Applicants disclose only the promoter region of a *Bacillus subtilis* *yvaWXY* gene, the invention is enabled with respect to use of a promoter region of a *Bacillus subtilis* *yvaWXY* gene, but not use of promoter regions of any *Bacillus sp.* *yvaWXY* gene. In order to expedite prosecution, Applicants have amended claims 1, 2, and 8 to recite that "the promoter region is of a *Bacillus subtilis* *yvaWXY* gene." Applicants note that the sequence of the *yvaWXY* gene and corresponding promoter were known at the time the invention was filed. Thus, the present Specification conveys to those of ordinary skill in the art that, at the time the application was filed,

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Applicants had full possession of the invention as currently claimed. Therefore, Applicants submit that the present disclosure provides a sufficient written description with respect to the subject matter claimed in claims 1, 2, and 8, as amended, and the claims depending therefrom. Accordingly, Applicants respectfully request withdrawal of this rejection. Applicants reserve the right to pursue claims to other promoter regions of a *Bacillus sp.* gene in a continuing application.

Claims 1-3, 8, and 14-16 also stand rejected under 35 U.S.C. § 112, first paragraph, for lacking enablement. The Examiner acknowledges that the Specification is enabling for a method using the promoter of *Bacillus subtilis ypaWXY*. In light of the amendments to claims 1, 2 and 8 and the remarks above, Applicants submit that the present disclosure sufficiently enables the invention as claimed, and respectfully request withdrawal of this rejection.

Claims 2-4, 8, 9, and 14-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Claim 2 has been amended to recite “at a time prior to about T0, removing oxygen from the transformed *Bacillus sp* cell.”

The Examiner states that claim 3 is indefinite because the metes and bounds of “oxygen is re-supplied to the transformed *Bacillus sp* cell” are unclear. Office Action at 8. Applicants respectfully disagree and request reconsideration. Claim 3 recites a “method according to Claim 2 wherein after step (c) oxygen is re-supplied to the transformed *Bacillus sp* cell.” Applicants submit that claim 3 is clear and is not indefinite as described in M.P.E.P. §§ 2173-2173.06. The metes and bounds of the recited step are easily ascertainable. The Examiner states that the claim is indefinite because the intended outcome of the method is not stated. The breadth of claim 3, however, does not necessarily render it indefinite. See M.P.E.P. § 2173.04.

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The Examiner contends that term "about T0" renders claim 8 indefinite. The fact that claim language is not precise does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Indus. Crating & Packing, Inc., 731 F.2d 818 (Fed. Cir. 1984); see also BJ Services Co. v. Halliburton Energy Services Inc., 67 USPQ2d 1692, 1695 (Fed. Cir. 2003) (upholding a jury's finding that the term "about" did not render the claims indefinite). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. See M.P.E.P § 2173.05(b). As defined in the specification and routine in the art, T0 designates the beginning of the stationary phase, and each hour after T0 is designated as T1, T2, etc, respectively. It is also generally known that the stationary phase is illustrated by the plateau of the growth curve after log growth, during which cell number remains relatively constant. As evidenced by bacterial growth curves, the transition from the log phase to the stationary phase is not instantaneous. Thus, "about T0" is not indefinite and one of ordinary skill in the art would readily understand the invention of claim 8.

For at least these reasons, Applicants respectfully request withdrawal of this rejection of claims 2-4, 8, 9, and 14-16.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Dated: 5/10/05

Respectfully submitted,
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